

REMARKS

I. Introduction

Claims 1, 2, 6-10, 12-18, 20-24, 26-37, 40-43, 45-48, and 50-63 are pending in this application.

Claims 1, 2, 6-10, 12-18, 20-34, 36, 37, 40-43, 45-48, and 50-63 were rejected under 35 U.S.C. § 102(e) as being anticipated by Srinivasan et al. U.S. Patent No. 6,357,042 ("Srinivasan"). Claim 35 was rejected under 35 U.S.C. § 103(a) as being obvious over Srinivasan. In addition, claims 1 and 37 were also rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 1 and 37 have been amended to more particularly define the claimed invention. The amendment is fully supported by the specification as originally filed and does not add new matter. The Examiner's rejections are respectfully traversed.

II. The § 112 Rejection of Claims 1 and 37

Each of claims 1 and 37 stands rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to point out and particularly claim the subject matter which applicants regard as the claimed invention. In support of this rejection, the Examiner states:

Claims 1 and 37 recite "receiving at the user equipment the plurality of advertisements related to at least one object." Said limitation is indefinite because it seems to recite that a plurality of advertisements are linked to a single object when Applicant[s]' specification teaches that an object is linked to a[] URL source and said URL source is used to pull or push advertisements located in said source.

(Office Action, page 2, #3). As explained in Applicants' Reply dated July 5, 2007 ("July Reply"), the rejection under § 112, second paragraph is improper because the Examiner's stated reasons for deeming the claims "indefinite" do not relate to any requirement under § 112, second paragraph. According to the MPEP, "[t]he requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles....Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." (MPEP

§ 2173.02). In this case, the Examiner has not advanced any argument that pertains to clarity or precision (or lack thereof) of claims 1 and 37. Rather, the Examiner appears to contend that the specification does not provide adequate support for the subject matter set forth in the claims, which is a separate and distinct issue from the requirements of § 112, second paragraph. Therefore, the rejection should be withdrawn for this reason alone.

Furthermore, without addressing the substantive merits of the rejection, Applicants have amended each of the claims more particularly define the claimed invention. Applicants believe that the amendments adequately address the Examiner's rejection. Therefore, Applicants request reconsideration and withdrawal of the § 112 rejection for this additional reason.

III. The § 102(e) Rejection

Each of claims 1, 2, 6-18, 20-34, 36, 37, 40-43, 45-48, and 50-63 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Srinivasan. This rejection is respectfully traversed.

According to the MPEP, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP 2131). Srinivasan fails to teach each and every limitation of at least the independent claims.

A. Independent Claims 1 and 37 Patently Distinguish Over Srinivasan

Independent claims 1 and 37 are directed to a method and a system for providing metadata-selected advertisements. As recited in the claims, a plurality of advertisements, media containing at least one object, and metadata relating to the object and advertisements are received at user equipment. The media, including the at least one object, is displayed on a viewing device. Upon receiving a user selection of one of the objects, metadata associated with the selected object is compared with metadata associated with the plurality of advertisements and one advertisement is selected based on the comparison. As explained in Applicants' July Reply, Srinivasan fails to describe this subject matter.

In particular, Srinivasan fails to describe receiving a plurality of advertisements at user equipment and selecting one of the advertisements by comparing at the user equipment metadata associated with a selected object and metadata associated with the advertisements received at the user equipment. The Action asserts that this subject matter is described in column 7, lines 25-50,

column 12, lines 20-35, and column 22, lines 1-10 of Srinivasan (see Office Action, page 4, lines 16-19). As explained in Applicants' July Reply, the cited sections fail to support the Action's contention. In particular, the cited sections make reference to presenting information to end users based on user interactions with an on-screen entity (see column 7, lines 45-50), invoking "a link to a network-based data server that may deliver" video media including interactive advertisements to an end user (see column 12, lines 20-34), and "downloading" of additional information regarding a user's interactions with a video steam (column 22, lines 1-10). The cited sections, however, do not describe comparing metadata of a selected object with metadata of advertisements at the user equipment and selecting one the advertisements received at user the equipment based on the comparison, as explicitly recited in claims 1 and 37.

In the Examiner's Response to Remarks made by Applicants in the July Reply on this subject matter, the Examiner contends that Srinivasan describes this subject matter in column 34, lines 1-25 and 55-67 (see Office Action, page 11, line 2). Applicants disagree.

Column 34, lines 1-25 of Srinivasan states in pertinent part:

[C]ombined [user] profiles may be created for each program by comparing individual known profiles from a total number of viewers likely to be accessing programs via CPE of the present invention. Additionally such advertisers [to be solicited] may be offered an opportunity to add certain interactive content such as URL's or the like to their video ads. In this case, ad server 221 may pull appropriate new adds [sic] based on the most updated statistical report showing current user-combined profile statistics. Under such an arrangement, ads created by different advertisers may be rotated in among different shows with profile matches retaining seniority

(Srinivasan, column 34, lines 8-18). This passage describes providing URLs in video ads that may be used to pull advertisements stored on ad server 221, each ad being pulled based on statistical information derived from user profiles. The passage however does not describe comparing metadata of a selected object with metadata of advertisements at the user equipment and selecting one the advertisements received at user the equipment based on the comparison, as explicitly recited in claims 1 and 37.

In addition, the other passage cited by the Examiner, i.e., Srinivasan column 34, lines 55-67, also fails to cure the deficiencies in the afore-described section. In particular, the cited passage states:

[U]ser premise 205 includes a set-top box or other computerized device capable of executing code. In many embodiments unique code is provided as a part of the service for adding functionality to the set-top box or other device used to receive and display video. Such added code comprises code, for example, to select among multiple ads that may be served to the device, based upon user-defined profile data. The user may, for example, enter a profile including sex and age. Then in receiving and preparing for display of data streams provided, the set-top box or other device will select to display those ads targeted to the profile, and not other ads that may be sent simultaneously. This facility can act as a selective filter in this respect.

(Srinivasan, column 34, lines 55-67). This cited passage describes a device that may execute code in order to select based on "user-defined profile data" one of multiple ads served to the device for display in order to ensure that only ads targeted to the user profile are displayed. Although the passage refers to selecting one of many ads based on a user profile, the passage fails to describe that the ad is selected by comparing metadata associated with a selected object with metadata associated with the advertisements, as specified in claims 1 and 37. In contrast, the passage expressly states that the ads are selected for display based on user-defined profile data. However, selecting an advertisement based on a comparison between metadata associated with a selected object in media and metadata associated with a plurality of advertisements at the user equipment is the explicit subject matter of claims 1 and 37. Therefore, Srinivasan fails to teach each and every element of claims 1 and 37, as is required for a rejection under § 102.

For at least the foregoing reasons, applicants respectfully request reconsideration and withdrawal of the § 102 rejection of amended independent claims 1 and 37. Claims 2, 6-10, 12-17, 40-42, and 54-63 depend from claims 1 and 37 and add further limitations thereto. Applicants therefore respectfully request reconsideration and withdrawal of the § 102 rejection of these claims for at least the same reasons.

B. Independent Claims 18, 32, 36, 43, 48, and 53 Patently Distinguish over Srinivasan

Independent claims 18, 32, 36, 43, 48, and 53 are directed to methods and systems for providing metadata-selected advertisements. As recited in the claims, a plurality of advertisements related to media are received at user equipment and one of the advertisements is selected by comparing, at the user equipment, metadata associated with the media with metadata

associated with the plurality of advertisements. As set forth above in Section III-A, Srinivasan does not describe this subject matter.

Applicants therefore request reconsideration and withdrawal of the § 102 rejection of claims 18, 32, 36, 43, 48, and 53. Claims 20-24, 26-31, 33-34, 45-47, and 50-52 depend from claims 18, 32, 36, 43, and 48 and add further limitations thereto. Applicants therefore request reconsideration and withdrawal of the § 102 rejection of these claims as well.

IV. The § 103 Rejection of Claim 35

Claim 35, which depends from independent claim 32, stands rejected under § 103(a) as being unpatentable over Srinivasan. The rejection of claim 35 relies, at least in part, on the same erroneous basis as the § 102 rejection of claim 32. As set forth above, Srinivasan fails to teach each and every element of claim 32. Applicants therefore respectfully request reconsideration and withdrawal of the § 103 rejection of claim 35 on the same grounds.

V. Conclusion

For at least the foregoing reasons, applicants respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

We believe that we have appropriately provided for fees due in connection with this submission. However, if there are any other fees due in connection with the filing of this Response, please charge our Deposit Account No. 06-1075 under Order No. 003597-0192-101 from which the undersigned is authorized to draw.

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Respectfully submitted,

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